

REMARKS/ARGUMENTS

Favorable reconsideration of the above-identified patent application, in light of the above amendments and the following remarks is respectfully requested. The presently pending claims are claims 1-3 and 6-11. Claims 1, 7, and 11 have been amended. Claims 4 and 5 have been canceled.

In the Office Action, the Examiner rejected claims 1 and 6-7 under U.S. C. 102(b) as being anticipated by U.S. Patent No. 5,267,756 to Molee (Molee). The Examiner stated that Molee discloses an authentication system in which a consumer communicate a product code from a tag on a product purchased by the consumer to an authentication agency that indicates authenticity of the product.

In response, the Applicant has amended independent claims 1 and 7 to better differentiate Applicant's invention from Molee. In addition, claim 8 depends from amended independent claim 7 and recites additional limitations in combination with the novel elements of claim 7. Molee discloses an authentication system utilizing a unique code number affixed to the product to authenticate the product. On the other hand, the Applicant's invention claims an authentication system which utilizes one-time use codes to authenticate products. The Applicant's invention discourages the duplication of authentication codes by only allowing the authentication of the product once. The Applicant's invention is primarily used by purchasers buying a product once, therefore one-time authentication codes are useful in preventing duplication. However, Molee does not teach or suggest utilizing one-time codes because Molee is utilized in the purchase and sale of memorabilia, which may be re-sold and where one-time codes would not be possible. Therefore, the withdrawal of the rejection and the allowance of claims 1 and 6-7 is respectfully requested.

The Examiner also rejected claims 1 and 6-7 under U.S. C. 102(b) as being anticipated by U.S. Patent Application No. 20030177095 to Zorab (Zorab). The Examiner stated that Zorab discloses an authentication system and method in which a consumer communicates a product code from a tag on a product purchased by the consumer to an authentication agency that indicates authenticity of the product.

In response, the Applicant has amended independent claims 1 and 7 to better differentiate Applicant's invention from Zorab. In addition, claim 8 depends from amended independent claim 7 and recites additional limitations in combination with the novel elements of claim 7. Zorab discloses an authentication system utilizing a unique code number affixed to the product to authenticate the product. On the other hand, the Applicant's invention claims an authentication system which utilizes one-time use codes to authenticate products. The Applicant's invention discourages the duplication of authentication codes by only allowing the authentication of the product once. The Applicant's invention is primarily used by purchasers buying a product once, therefore one-time authentication codes are useful in preventing duplication. However, Zorab does not teach or suggest utilizing one-time codes which are useful in combating the duplication of the codes. Therefore, the withdrawal of the rejection and the allowance of claims 1 and 6-7 is respectfully requested.

The Examiner also rejected claims 2, 4, 5, 8, 9 and 11 under 35 U.S.C. 103(a) as being unpatentable over Molle or Zorab in combination with Shoshani. The Examiner stated that Shoshani discloses means and method to authenticate objects using a pair of number corresponding to the

claimed identification number and product code. The Examiner stated that Shoshani also discloses using a control number which may be changed so the authentication code is only used once.

In response, the Applicant has amended independent claims 1, 7 and 11 to better differentiate Applicant's invention from the cited references. In addition, claim 2 depends from amended independent claim 1 and recites additional limitations in combination with the novel elements of claim 1. Claim 8 and 9 depend from amended independent claim 7 and recites additional limitations in combination with the novel elements of claim 7. Claims 4 and 5 have been canceled. As discussed above, none of the references teach or suggest utilizing a one-time authentication code on a product. Shoshani merely discloses a control system authenticating serially number objects. The serially number objects are merely negotiable items such as checks, bonds, etc. Shoshani does disclose providing a control number associated with the serially numbered object only one time and then changing the control number for later use. The Applicant's invention claims an authentication system for authenticating products rather than serially number objects. Shoshani is non-analogous art because Shoshani is related to serially numbered objects which is completely different than products.

In addition, the Applicant respectfully disagrees in that it would be obvious to one of ordinary skill to combine Molee or Zorab and Shoshani. For prior art references to be combined to render obvious a subsequent invention under Section 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so.

In re Fine, 5 U.S.P.Q.2d at 1599. Hindsight is strictly forbidden. It is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. *Id.* At 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Circ. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Shoshani relates specifically with sequentially numbered objects and not ordinary products traded in commerce. Therefore, the withdrawal of the rejection and the allowance of claims 2, 8, 9 and 11 is respectfully requested.

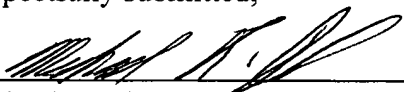
The Examiner rejected claims 3 and 10 under 35 U.S.C. 103(a) as being unpatentable over Moore Molee or Zorab in combination with Shoshani and U.S. Patent No. 6,591,252 to Young (Young) or U.S. Patent No. 4,191,376 to Goldman (Goldman). The Examiner stated that Young discloses an authentication apparatus and method with product code obscured by packaging or tamper proof removable seal. The Examiner stated it would have been obvious to one of ordinary skill in the art to have included in the combination applied above the product code concealed by removable strip as disclosed in Young or Goldman to further increase the difficulty of counterfeiting. In response, the Applicant has amended independent claims 1 and 8 to better differentiate Applicant's invention from the cited references. In addition, claim 3 depends from amended independent claim 1 and recites additional limitations in combination with the novel elements of claim 1. Claim 10 depends from amended independent claim 7 and recites additional limitations in combination with the novel elements of claim 7. None of the cited inventions teaches or suggest the

use of one-time authentication codes on products. Therefore, the withdrawal of the rejection and the allowance of claims 3 and 10 is respectfully requested.

CONCLUSION

For all the above reasons, the Applicant respectfully requests the reconsideration and withdrawal of the rejection and the allowance of claims 1-3 and 6-11.

Respectfully submitted,



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